

REMARKS/ARGUMENTS

Claims 1-7, 9-17, 19-25, 27-37, and 39-70 are pending in the present application.
Reconsideration of the claims is respectfully requested.

I. Application to be Considered Special

This application has received a fifth, non-final Office Action. As per MPEP § 707.02, Applicants respectfully request that the Supervisory Patent Examiner personally check on the pendency of this application and make every effort to complete prosecution of this application.

II. 35 U.S.C. § 103, Obviousness – Claims 13-16, 19-24, 27-31, 53-55, 57-58, and 66

II.a. Claims 13, 53, and 66

The Office rejects claims 13-16, 19-24, 27-31, 53-55, 57-58, and 66 under 35 U.S.C. § 103(a) as being unpatentable over Imielinski et al. (U.S. Patent Application Publication No. 2002/0013792 A1). This rejection is respectfully traversed.

As to claims 13, 53, and 66, the Office states:

Regarding independent claims 13, 53, and 66:

Imielinski discloses receiving a first web document in fig. 1 and paragraphs (0036) – (0040). The first web document is called the original electronic document in Imielinski. Imielinski teaches receiving a request to change a font attribute of a selected portion of the first web environment in fig. 4, fig. 9B, paragraphs (0049) – (0054), and (0067). Imielinski also provides an example in paragraph (0014) that virtual tags, for example, could be used to display text of the original document in a red font on the virtual page. Imielinski discloses creating in the web browser a second web document from the first web document wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents in fig. 1, fig. 3, paragraphs (0036) – (0040), and paragraphs (0042) – (0048). In Imielinski, the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according to the transformation rules generated by the user. See also Response to Arguments, made applicable herein by this reference.

Office Action dated April 26, 2006, page 3.

Claim 13, which is representative of the other rejected independent claims 53 and 66 with regard to similarly recited subject matter, reads as follows:

13. A method in a web browser on a data processing system for processing a document, said method comprising:
receiving a first web document;
receiving a request to change a font attribute of a selected portion of the first web document; and
creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents.

The Office uses Imielinski et al. that has a filing date of December 28, 2000 and claims benefit of a Provisional Application (Provisional Application No. 60/173,757) which has a filing date of December 30, 1999. Therefore, Applicants respectfully submit only the information disclosed in the Provisional Application may be used as prior art because any added material in Imielinski when filed December 28, 2000 does not qualify as prior art. Provisional Application 60/173,757 has been included with this response.

The Office alleges:

The standard for evaluating whether a preceding Provisional Application properly supports the subject matter relied upon to make a rejection based on a Non-Provisional Application is whether the subject matter meets the requirements of 35 U.S.C. 112, first paragraph. See, MPEP, 2136.03(111).

The inquiry is not whether a claim limitation in question is taught expressly in the underlying Provisional Application under a 35 U.S.C. 102 analysis, but whether the subject matter cited as prior art is properly supported by the underlying Provisional Application under a 35 U.S.C. 112, first paragraph analysis. Upon a finding that the subject matter in the Non-Provisional Application is properly supported by the underlying Provisional Application, under the 35 U.S.C. 112, first paragraph analysis, then the subject matter is entitled to the benefit of the earlier filing date. Accordingly, the expression of the subject matter in the Non-Provisional Application is also accorded the benefit of the earlier filing date and citation to the underlying Provisional Application is not necessary.

Regarding the rejections of claims **13-16, 19-24, 27-31, 53-55, 57, 58, and 66**:

Under the standard expressed above, the Examiner believes the rejection of claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 under 35 U.S.C. 102(e) to have been proper. The Examiner also recognizes a colorable argument in Applicants' Response to Office action in that the strength of citation to the Non-Provisional Application of Imielinski turns on interpretation of whether the subject matter was supported by the prior Provisional Application. Upon consideration of Applicants' arguments, the Examiner withdraws the rejection of claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 under 35 U.S.C. 102(e). However, upon further consideration, a new ground of rejection is made under 35 U.S.C. 103(a). Accordingly, Applicants' arguments regarding 35 U.S.C. 102(e) are moot.

Applicants argue that the Provisional Application does not teach the following limitations as recited in independent claim 13: *"receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within*

the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language document.” See, Response to Office Action, pages 17 and 18.

Applicant fails to specifically identify which elements of the cited portion of claim 13 are not taught by the Provisional Application. It is believed by the Examiner that the deficiency in the cited prior art related to the limitation “receiving a request to change a font attribute.” See, Response to Office Action, page 18.

Since the Applicants quote solely from claim 13, only claim 13 will be addressed, and the response will apply to independent claims 53 and 56, and to dependent claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 by virtue of their dependency on independent claims 13 and 53, according to the relationship argued by the Applicants. It is noted for clarification that the prior art cited against claim 13 was cited from the Patent Application Publication, “Imielinski.”

Imielinski teaches creating a virtual page or second web document from a first web document using virtual tags. The virtual tags identify the original document content or a selected portion of the original document content for creation of the virtual page. The virtual tags have the ability to manipulate the formatting information, such as font attribute information, in the subsequent web document, called a virtual page by Imielinski. Batres teaches previewing and printing a web document via an HTML renderer. The content and formatting may be manipulating in the HTML renderer. Batres also defines a multiple-page HTML document, which can demarcate HTML document information among a plurality of pages. All limitations of claim 13 are taught in Imielinski, except that the limitation of a “font attribute” is not expressly taught in the Provisional Application. See, Provisional Application, page 5, line 30 through page 6, line 3.

The Provisional Application discusses modification of the text to color it red in order to draw attention to the text. See, Provisional Application, page 2, lines 27-29. The Provisional Application is expressly not limited to the disclosed embodiments, and it is recognized that other arrangements can be readily devised by those skilled in the art.

Modification of the font attribute is expressly taught in Imielinski. See, Imielinski, fig. 9B, paragraph (0049) [Table 1], paragraph (0067) - (0068), and claims 6, 41, and 74.

It would have been obvious to one of ordinary skill in the art at the time of the invention to change the font in a text. The suggestion or motivation for doing so is taught in the Provisional Application that the tags can be “visualized on the source web page,” with the obvious and beneficial advantage to changing text color or font being to draw the reader’s attention to the text.

35 U.S.C. 112, first paragraph reads as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicants agree with the Office’s assertion that the Provisional Application must meet with the requirements of 35 U.S.C. 112, first paragraph. Applicants respectfully submit that Imielinski’s Provisional Application does not meet with the requirements of 35 U.S.C. 112, first paragraph, in that,

Imielinski's Provisional Application does not provide a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same that would teach or suggest receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents, as recited in claim 13.

In the Provisional Application, Imielinski describes tagging portions of web pages by readers of the pages rather than by the page owners. The tags used by Imielinski are defined by a combination of context, structure of the page, item lists, and other content defined predicates. The tags are tied to the page's content through procedural action and descriptive expressions in a unique language. The tags, which are considered virtual because they exist physically apart from the text of the web page they tag, are stored in a virtual tag repository. The virtual tag repository maintains a count of how often each virtual tag has been used and can communicate this information back to the owner of the source page. Imielinski also describes virtual active tags that can be used for sending messages about pre-specified changes of the tagged content to the user. Finally, Imielinski describes that virtual tags and virtual active tags can be used to set up personalized selections of services for any web site.

The Office alleges that Imielinski teaches receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents in the following sections:

We claim:

A system for marking at least a portion of a web page comprising:

(Imielinski, Provisional Application, column 5, line 30 to column 6, line 3)

Virtual tags can be virtualized on the source page, presenting the "user interest" distribution on different segments of the page. For example, frequently accessed or referenced areas on the page can be displayed in a different color, i.e. red.

(Imielinski, Provisional Application, column 2, lines 27-29)

In these sections of the Provisional Application, Imielinski describes that a portion of a web page may be marked or virtualized on the source page. The marking on the source page may be in a different color. Thus, Imielinski merely uses data that is collected for frequently accessed or referenced areas, to mark on

the source page those areas that are frequently accessed or referenced. Applicants respectfully submit that Imielinski's does not teach or suggest receiving a request to **change a font attribute of a selected portion of the first web document**. Additionally, Imielinski does not teach or suggest creating a **second web document** in the web browser **from the first web document**, wherein the font attribute, within the second web document, of the selected portion is changed **in response to receiving the request to change the font attribute of the selected portion**.

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Since the reference fail to teach or suggest receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents, the Office has failed to establish a *prima facie* case of obviousness, because the Office does not show where each and every claim limitation is taught or fairly suggested by the applied prior art.

The applied reference does not teach or suggest each and every claim limitation; therefore, Imielinski does not render claim 13 obvious. Independent claims 53 and 66 recite similar subject matter addressed above with respect to claim 13 and are allowable for similar reasons. Since claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 depend from claims 13 and 53, the same distinctions between Imielinski and the invention recited in claims 13, 53, and 66 apply for these claims. Additionally, claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 recite other additional combinations of features not taught or suggested by the references.

Furthermore, no suggestion is present in the reference to modify the reference to include such features. That is, there is no teaching or suggestion in Imielinski that a problem exists for which receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents, is a solution. To the contrary, Imielinski appears to teach using data that is collected for frequently accessed or referenced areas, to mark on the source page those areas that are frequently accessed or referenced.

In view of the above, Applicants respectfully submit that the Imielinski fails to teach or suggest the features of claims 13, 53, and 66. At least by virtue of their dependency on claims 13 and 53, the features of dependent claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 are not taught or suggested by

Imielinski. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 under 35 U.S.C. § 103.

II.b. Claims 14-16, 19-24, 27-31, 54, 55, 57, and 58

In addition to their dependency from independent claims 13 and 53, the specific features recited in dependent claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 are not taught by Imielinski. For example, with regard to claims 14, 22, 54, and 57, the Provisional Application of Imielinski does not teach the step of creating the second web document includes inserting virtual font indicators before and after text within the selected portion. As discussed above, Imielinski merely inserts virtual tags and virtual active tags that describe a combination of context, structure of the page, item lists, and other content defined predicates. There is no mention whatsoever in the Provisional Application of virtual font indicators.

With regard to claims 16, 24, 55, and 58, the Provisional Application of Imielinski does not teach the selected portion being displayed according to the virtual font indicators. As discussed above, Imielinski merely inserts virtual tags and virtual active tags that describe a combination of context, structure of the page, item lists, and other content defined predicates. While the virtual tags and virtual active tags of Imielinski may be displayed for the owner of the page, the virtual tags and virtual active tags described in the Provisional Application do not include any font information and Imielinski does not display any information according to any virtual font indicators.

With regard to claim 30, the Provisional Application of Imielinski does not teach the step of creating the second web document comprises creating a copy of the first web document and changing the font attribute of the selected portion within the copy of the first web document. As discussed above, Imielinski merely inserts virtual tags and virtual active tags that describe a combination of context, structure of the page, item lists, and other content defined predicates. Imielinski does not teach creating a copy of a first web document, changing a font attribute of a selected portion within the copy of the first web document, and then creating a second web document.

With regard to claim 31, the Provisional Application of Imielinski does not teach the step of creating the second web document comprises changing the font attribute of the selected portion within the first web document to create the second web document. As discussed above, Imielinski merely inserts virtual tags and virtual active tags that describe a combination of context, structure of the page, item lists, and other content defined predicates. Imielinski does not teach changing a font attribute of a selected portion within the copy of the first web document, and then creating a second web document.

Therefore, in addition to being dependent on independent claims 13 and 53 respectively, dependent claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 are also distinguishable over Imielinski by

virtue of the specific features recited in these claims. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 14-16, 19-24, 27-31, 54, 55, 57, and 58 under 35 U.S.C. § 103.

III. 35 U.S.C. § 103, Obviousness - Claims 1-7, 9-12, 17, 25, 32-37, 39-48, 51-52, 56, 59-65, and 67-70

The Office rejects claims 1-7, 9-12, 17, 25, 32-37, 39-48,, 51-52, 56, 59-65, and 67-70 under 35 U.S.C. § 103(a) as being unpatentable over Imielinski et al. (U.S. Patent Application Publication No. 2002/0013792 A1) and further in view of Batres (U.S. Patent No. 6,832,351 B1). This rejection is respectfully traversed.

As to claims 1, 48, and 65, the Office states:

Regarding independent claims 1, 48, and 65:

Imielinski teaches receiving a first web document including formatting information used to display the first web document in fig. 1 and paragraphs (0036) – (0040). The first web document is called the original electronic document in Imielinski. Imielinski teaches receiving a request to present a selected portion of the first web document in fig. 1, fig. 3, paragraphs (0036) – (0040), and paragraphs (0042) – (0048). The request and selected portion are defined in the transformation information of Imielinski. Imielinski teaches identifying formatting information associated with the selected portion of the first web document and creating in the web browser a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving the request, wherein the first web document and the second web document are markup language documents in fig. 1, fig. 3, paragraphs (0036) – (0040) and paragraphs (0042) – (0048). In Imielinski the second web document is called the virtual page. The virtual page is the requested portion of the original electronic document that selected and customized according ‘to the transformation rules generated by the user. Imielinski teaches responsive to a request to change a font attribute of the selected portion, inserting virtual font indicators before and after text within the selected portion in fig. 4, fig. 9B, paragraphs (0049) – (0054), and (0067). Imielinski also provides an example in paragraph (0014) that virtual tags, for example, could be used to display text of the original document in a red font on the virtual page. Imielinski does not teach responsive to a request to identify a page break in the selected portion, inserting at least one virtual page break indicator within the selected portion.

Batres does teach enhancing a web document by inserting and manipulating one or more virtual page break indicators to implement pagination for printing preview in fig. 2, fig. 5, col. 2 lines 28-43, col. 4 line 57 – col. 5 line 52, col. 8 lines 20-46. Batres teaches that the HTML preview rendering can accept data manipulation, formatting, and content changes. Batres also teaches that the page breaks are part of the multiple-page HTML format documents as described in col. 8 lines 20-46.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Imielinski and Batres to have created the claimed invention. It would have been obvious and desirable to have used the HTML preview rendering as taught by Batres to have improved the virtual page creation

and display as taught by Imielinski. The combination would have enabled a user to have further manipulated a virtual page, including page breaks, to have previewed and prepared the document for output to a printing device.

Office Action dated April 26, 2006, pages 7-8.

The deficiency of Imielinski has been addressed above. Applicants respectfully submit that the Imielinski and Batres, taken alone or in combination, fail to teach or suggest the similar features recited in independent claims 1, 32, 47, 48, 60, 64, 65, and 67-70. That is, Imielinski fails to teach or suggest receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents, as recited in independent claim 13. Batres does not make up for the deficiencies of Imielinski, as Batres fail to teach or suggest receiving a request to change a font attribute of a selected portion of the first web document; and creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents.

In view of the above, Applicants respectfully submit that Imielinski and Batres, taken alone or in combination, fail to teach or suggest the features of claims 1, 13, 32, 47, 48, 53, 60, 64-66, and 67-70. At least by virtue of their dependency on claims 1, 13, 32, 48, 53, and 60, the features of dependent claims 2-7, 9-12, 17, 25, 33-37, 39-46, 49-52, 56, 59, and 61-63 are not taught or suggested by Imielinski and Batres, whether taken individually or in combination. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-7, 9-12, 17, 25, 32-37, 39-48, 51, 52, 56, 59-65, and 67-70 under 35 U.S.C. § 103.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE:

July 24, 2006

Respectfully submitted,

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